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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/593,060	06/13/2000	Tatsuya Eguchi	52178-020	5731

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MCDERMOTT WILL & EMERY LLP  
600 13TH STREET, N.W.  
WASHINGTON, DC 20005-3096

EXAMINER
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HAŃ, QI

ART UNIT	PAPER NUMBER
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2626

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/12/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No. 09/593,060	Applicant(s) EGUCHI ET AL.	
	Examiner Qi Han	Art Unit 2626	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 December 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-14 and 16-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-14 and 16-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Response to Amendment***

2. This communication is responsive to the applicant's amendment dated 12/12/2006. The applicant(s) amended claims 3, 6 and 17 (see the amendment: pages 2-7).

The examiner withdraws the objection of claim 3, because the applicant amended the claim.

The examiner withdraws the rejection of claims 1 and 3-5 under 35 USC 112 1<sup>st</sup>, because the applicant further explained/clarified the limitation (the amendment: page 8, paragraph 4 to page 9, paragraph 1).

#### ***Response to Arguments***

3. Applicant's arguments filed on 03/07/2006 with respect to the claim rejection under 35 USC 103, have been fully considered but are moot in view of the new ground(s) of rejection, since the amended claims introduce new issue and/or change the scope of the claims. It is noted that the previous cited references are still applicable to the newly amended claims for rejection and the response to the arguments is directed to the corresponding claim rejection (see detail below).

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4. Applicant's arguments with respect to the rejection of claims 6, 10-11 and 17-18 under 35 USC 112 1<sup>st</sup>, have been fully considered but they are not persuasive.

In response to applicant's arguments with respect to the rejection of claims 6, 10-11 and 17-18 under 35 USC 112 1<sup>st</sup>, that "it is improper for the Examiner to state that the specification does not describe how to specify document data of a document, when he alleged that document data covers the range of "document data of a document" and "this limitation does not prevent one skilled in the art from making or using the invention" (the amendment: page 9, paragraph 2), the examiner disagrees with the applicant's arguments. Firstly, it is noted that according to the applicant's arguments, it appears that a narrow prior art disclosure used by examiner for rejecting a broader claim limitation should or would be as part of the applicant's invention. This is a wrong logic and the argument itself is improper. Secondly, it is noted that the prior art rejection and new matter rejection are separate and different issues, and intending to mix them together for attacking examiner's statements, in this case, cannot overcome the claim rejection under 35 USC 112 1<sup>st</sup>. Thirdly, it is noted that in the arguments, the applicant failed to specifically point out **where** the claimed limitation is disclosed in the original specification. Finally, the applicant is silenced about and failed to respond to the **enablement** rejection under 35 USC 112 1<sup>st</sup>. It is noted that, as stated in the rejection, the original specification does not specifically describe how to specify document data of **a document** including a plurality of different languages to be translated and outputted into a plurality of languages by language groups, as claimed (see the closest disclosure in Fig. 2-5 and 12-16), therefore, the claimed limitation was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention, without undue experimentation.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 6-10 and 17-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 6, the newly amended claim limitation “wherein, in a case where the prescribed mode is set and the document data of the document includes **a plurality of different languages**, said controller controls said translating means so as to translate the document data into at least one language, and controls said output unit so as to output the translated document data by groups, each group of the **translated document data** comprising a printed document in the original language and printed documents of the translated document data translated in each of the plurality of languages with each of the printed documents being distinct from one another” causes an indefinite problem, because it is unclear that which original language of “a plurality of different languages” is referred to. Further, if it refers to the original copy of document, it conflicts with the limitation of “the **translated** document data”.

Regarding claims 7-10, the rejection is based on the same reason described for claim 6, because the dependent claims include the same or similar problematic limitations as claim 6.

Regarding claim 17, the newly amended claim limitation “by groups, each group of the translated document data comprising a printed document in the original language and printed documents of the translated document data translated in each of the plurality of languages with

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each of the printed documents being distinct from one another” has an indefinite problem, because it is unclear that what the specific criterion for grouping is. It appears that each group is the same as or mixed with the other group.

Regarding claim 18, the rejection is based on the same reason described for claim 17, because the dependent claim includes the same or similar problematic limitations as claim 17.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

6. Claims 6, 10-11 and 17-18 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claims 6 and 10, since the amended claim 6 clearly points out that “the document data of the document (referring to “a document”) includes a plurality of different languages”, the claim 10 (depending on claim 6) that inherits the limitation of claim 6 and further recites the limitation “wherein, in a case where a plurality of languages to be translated are specified by said operation unit, said controller controls said translating means so as to translate each original language into the plurality of languages to be translated, and controls said output unit so as to output the plurality of translated languages by groups, the translated language of each group being different from one another”, **as whole**, introduces new subject matter. It is noted that the original specification does not specifically describe how to specify document data of **a document** including a plurality of different languages to be translated into a plurality of languages and outputted by language groups, as claimed.

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Regarding claim 11, the new added limitation “each in different language” causes the similar problem as described for claims 6 and 10, so that the rejection is based on the same reason described above.

Regarding claims 17-18, the amended claim 17 and claim 18 has similar problem as described for claims 6 and 10, so that the rejection is based on the same reason described above.

7. Claims 6, 10-11 and 17-18 are also rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claims 6 and 10, since the amended claim 6 clearly points out that “the document data of the document (referring “a document”) includes a plurality of different languages”, the claim 10 (depending on claim 6) inherits the limitation of claim 6 and further recites that “wherein, in a case where a plurality of languages to be translated are specified by said operation unit, said controller controls said translating means so as to translate each original language into the plurality of languages to be translated, and controls said output unit so as to output the plurality of translated languages by groups, the translated language of each group being different from one another”, which, as whole, has enablement problem. It is noted that the original specification does not specifically describe how to specify document data of a **document** including a plurality of different languages to be translated and outputted into a plurality of languages by language groups, as claimed (see the closet disclosure in Fig. 2-5 and

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12-16), therefore, the claimed limitation was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention, without undue experimentation.

Regarding claim 11, it is similar to claim 10, so that the rejection is based on the same reason described for claim 10 (see above).

Regarding claims 17-18, since they are similar to claims 6 and 10, the rejection is based on the same reason described for claims 6 and 10 (see above).

### ***Claim Rejections - 35 USC § 103***

8. Claims 1, 4-14 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamauchi et al. (5,701,497) hereinafter referenced as Yamauchi, in view of Fujita (5,612,872) and Flores et al. (6,370,498 B1) hereinafter referenced as Flores.

As per **claim 6**, as best understood in view of the claim rejection under 35 USC 112 1<sup>st</sup> and 2<sup>nd</sup> (see above), Yamauchi teaches a translating apparatus comprising:

“translating means for translating document data of a document into another language” (Fig.1 and col. 7, lines 41-54, ‘translation unit 9’);

“an output means for outputting the translated document data translated by said translating means” (col. 4, line 36 to col. 5, line 11, ‘output means for outputting said received document (including translated document data); Fig. 1, ‘bitmap exp 10’ and ‘plotter 11’, ‘PC/WS 12’; col. 7, lines 54-55, ‘the translating unit 9 supplies the output text data...for transfer to the personal computer 12’);



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“a mode setting unit for setting the translating apparatus in a first mode or a second mode” (col. 4, lines 36-60, ‘wherein one of said first and second output means is selectively activated (mode setting)’);

“a controller”, ( col.,7, lines 55-56, ‘the system of Fig. 1 includes a system controller’, which necessarily controls each unit, such as ‘OCR’, ‘translation’ and ‘outputs text data representing the result of translation’ );

“wherein, in a case where the prescribed mode is set [and the document data of the document includes a plurality of the different languages,] said controller controls said translating means so as to translate the document data into at least one language, and controls said output unit so as to output the translated document data”, (col. 4, lines 39-45, ‘translating a received document, written in a first language, to a second, different language...output...in said second language... wherein one of said first and second output means is selectively activated (setting mode)’; col.,7, line 48, ‘outputs text data representing the result of translation’ (necessarily including printed document));

But, Yamauchi does not expressly teach “the document data of the document includes a plurality of different languages”. However, this feature is well known in the art as evidenced by Fujita who discloses machine translation system (title) using a translation dictionary for storing related words of a same meaning in at least three languages including source language and the target language (abstract), comprising the translation “when there are a number of different languages mixed in the same text (document)” (Fujita: Fig. 18 and col. 9, lines 56-58). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Yamauchi by providing translation with a number of different languages mixed in the

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same text (document), as taught by Fujita, for the purpose (motivation) of effectively assisting the checking process for translation between many languages (Fujita: col. 1, lines 10-11).

Further, Yamauchi in view of Fujita does not explicitly teach outputting the translated document data "by groups, each group of the translated document data comprising a printed document in the original language and printed documents of the translated document data translated in each of the plurality of languages with each of the printed documents being distinct from one another". However, the feature is well known in the art as evidenced by Flores who discloses apparatus and methods for multilingual user access (title), comprising that 'the database stores translation of documents in multiple languages and a variety of formats', 'user can choose to have the multiple translations' and 'to have a work displayed (output) in a written text in two or more separate languages' (Figs. 3-4 and col. 3, line 64 to col. 4, line 8, and col. 5, lines 27-57), viewing and choosing two or more languages presented adjacently on display (col. 6, lines 47-54 and Figs. 5A-5B), which suggests the system has capability of outputting multiple languages in different combinations, including groups, such as different formats (contents) in one of languages (by language groups), or one of formats in different languages (by groups or common groups). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to recognize that computer based translation system having multi-language translation dictionary and database and presentation would have capability of outputting multiple languages in various combinations and/or groups for displaying or printing, and to modify Yamauchi in view of Fujita by providing translating document data in multiple languages and outputting (displaying or printing) the data in different languages and/or groups, as taught by Flores, for the purpose (motivation) of being beneficial to users presenting and

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displaying a written text and its multiple translations in two or more separate languages (Flores: col. 4, lines 5-8).

As per **claim 7** (depending on claim 6), Yamauchi further teaches “said output unit includes a printing device for printing the translated document data in a sheet” (Fig. 1, ‘plotter 11’).

As per **claim 8** (depending on claim 6), Yamauchi teaches “said output unit includes a display for displaying the translated document data” (Yamauchi: Figs. 2 and col. 8, lines 33-34, ‘display unit 33’).

As per **claim 9** (depending on claim 6), Yamauchi in view of Fujita teaches “an operation unit for specifying a plurality of original languages and at least one language to be translated” (Yamauchi: Figs. 2 col. 7, lines 62, ‘system controller’, ‘input device 32 used by an operator’; Fujita: Figs 14-18 and col. 9, lines 5-40, ‘allow for the selection of one of source language display, specified language display, and language family display...by giving language code’; col. 9, lines 56-58, ‘even when there are a number of different languages mixed in the same text (document)’; col. 9, lines 56-58, ‘even when there are a number of different languages mixed in the same text (document); which necessary includes specifying the related languages for the translation).

As per **claim 10** (depending on claim 9), as best understood in view of rejection under 35 USC 112 1<sup>st</sup> and 2<sup>nd</sup> (see above), the rejection is based on the same reason described for claim 6, because the rejection for claim 6 covers the same or similar limitations as claim 10.

As per **claim 11**, as best understood in view of rejection under 35 USC 112 1<sup>st</sup> (see above), the rejection is based on the same reason described for claim 6, because the rejection for claim 6 covers the same or similar limitations as claim 11.

As per **claims 12-13** (depending on claim 11), the rejection is based on the same reason described for claims 7-8 respectively, because the claims recite the same or similar limitations as claims 7-8 respectively.

As per **claim 14**, the rejection is based on the same reason described for claim 11, because the rejection for claim 11 covers the same or similar limitations as claim 14.

As per **claim 16** (depending on claim 14), the rejection is based on the same reason described for claim 8, because the claim recites the same or similar limitations as claim 8.

As per **claim 17**, as best understood in view of rejection under 35 USC 112 1<sup>st</sup> (see above), the rejection is based on the same reason described for claim 6, because the claim recites the same or similar limitations as claim 6.

As per **claim 18** (depending on claim 17), as best understood in view of rejection under 35 USC 112 1<sup>st</sup> (see above), the rejection is based on the same reason described for claim 10, because the rejection for claim 10 covers the same or similar limitations as claim 18.

As per **claim 1**, the rejection is based on the same reason described for claim 6, because the rejection for claim 6 covers the same or similar limitations as claim 1.

As per **claims 4-5** (depending on claim 1), the rejection is based on the same reason described for claims 8-9 respectively, because the claims recite the same or similar limitations as claims 8-9 respectively.

9. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamauchi in view of Fujita and Flores, and further in view of Miyahara et al. (6,314,213 B1) hereinafter referenced as Miyahara.

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As per **claim 3** (depending on claim 1), Yamauchi in view of Fujita and Flores does not explicitly teach “said output includes a sorter for sorting printed sheets by the group”. However, this feature is well known in the art as evidenced by Miyahara who teaches using ‘a sorter 22’ for discharging ‘paper sheet’ (Fig.2) (col. 7, lines 28-29) and ‘a soft key which is used to sort, staple/sort’ ) (col. 8, line 12). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Yamauchi in view of Fujita and Flores with Miyahara by providing a sorter and related sorting functionality, as taught by Miyahara, for the purpose of implementing user preferred function, like sorting the resultant sheets (Miyahara: col. 8, lines 4-13).

### *Conclusion*

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Qi Han whose telephone numbers is (571) 272-7604. The examiner can normally be reached on Monday through Thursday from 9:00 a.m. to 7:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richemond Dorvil, can be reached on (571) 272-7602.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Inquiries regarding the status of submissions relating to an application or questions on the Private PAIR system should be directed to the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028 between the hours of 6 a.m. and midnight Monday through Friday EST, or by e-mail at: [ebc@uspto.gov](mailto:ebc@uspto.gov). For general information about the PAIR system, see <http://pair-direct.uspto.gov>.

QH/qh  
March 2, 2007

  
RICHEMOND DORVIL  
SUPERVISORY PATENT EXAMINER